

II. REMARKS

To highlight the distinction of the above referenced invention over the prior art as interpreted by the Examiner in the Office Action of March 8, 2007, the pending independent claims were amended as set forth herein. Independent Claims 1, 21, and 41, and dependent Claims 4, 24, 44 were amended to more clearly define the subject matter of the invention and to place all of the claims remaining in the application in condition for allowance. The amendments to the independent claims is without inference of abandonment of the broad subject matter previously recited in such amended claims, and without prejudice to applicants' right to file one or more divisional or other continuing applications directed to the subject matter of the amended claims and to the filing date of the present application. Thus, claims 1-6, 8-26, 28-46, and 48-60 remain pending in the present application.

No new matter is presented in the amendments to the specification, claims, and drawings, and such amendments are believed to be unobjectionable. Entry thereof is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

A. Claim Rejections Under 35 U.S.C. §101

Claims 1-6, 8-26, 28-46, and 48-60 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter allegedly because Applicants' claimed invention assigns access rights to received information and does not use the assigned access rights and, thus, is "non-functional descriptive material." Applicants respectfully assert that the rejection under 35 USC §101 is improper for the following four reasons.

First, Applicants' claimed invention includes far more than non-functional descriptive material. According to the § 2106.01 of the MPEP, "functional descriptive material" includes of data structures and computer programs that impart functionality when employed as a computer component, whereas "nonfunctional descriptive material" includes music, literary works, and a compilation or mere arrangement of data.

Here, Applicants' independent claims include more than a compilation or mere arrangement of data. According to Applicants' independent claims, a real estate record is created on one or more servers, a record identifier is assigned to the real estate record, information is received from a fax source, a sender is prompted to input the record identifier into the fax source, the information is associated with the real estate record using the record identifier, and the information is stored in association with the real estate record. Therefore, Applicants' independent claims impart, at least, the functionality of associating the real estate record and the information, as well as the storing of the information in association with the record. It is difficult to imagine how anyone – especially one of ordinary skill in the art – could equate the utility of Applicants' independent claims with music, literary works, or mere arrangement of data when Applicants clearly set forth affirmative computing actions to be taken on information.

Second, the claims are not directed to a judicial exception to statutory subject matter and, in fact, fall within one or more of the four categories of inventions defined below in 35 U.S.C. §101 as being eligible for patent protection:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

The Supreme Court has interpreted the statutory range of patentable subject matter to be quite broad. "In choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193 (1980).

To begin an analysis of whether a claim is statutory subject matter under §101, USPTO personnel must ascertain whether the scope of the claim covers a §101 judicial exception. (MPEP, § 2106[IV][C][1], pp. 2100-11) The judicial exceptions to statutory subject matter include laws of nature, natural phenomena, and abstract ideas. *Diamond v. Diehr*, 450 U.S.175, 185, 209 USPQ 1, 7 (1981). The "useful, concrete, and tangible result" test applied by the Examiner is not applicable until there is a determination that the claim is directed to one of the judicial exceptions. MPEP § 2106[IV][C][2], p. 2100-11.

Here, Applicants' claims are directed to one or more of the four categories of statutory subject matter, namely a process, a machine, and/or a manufacture, and do not fall into one of the judicial exceptions. Independent claim 1 is directed to a process. Independent claim 21 is directed to a system; a type of machine. Independent claim 41 is directed to a computer readable medium storing a computer program; a type of manufacture.

Independent claim 1 is directed to a method performed on a machine, and as such, the claim is not drawn to an abstraction and does not fall within one of the judicial exceptions. Specifically, claim 1 recites limitations directed to a method centralized on at least one server and carried out over a distributed computer network to a plurality of client computers. As such, this claim is directed to a method performed using at least one machine and is directed to interactions between machines. As explained in *Ex Parte Whitcomb*, claims directed to a method

performed on a machine are not drawn to an abstraction and do not fall within one of the aforementioned § 101 judicial exceptions. *Ex Parte Whitcomb*, Appeal No. 2006-1187, p.13 (BPAI 2006)

Independent claim 21 is directed to a system including at least one server, a distributed computer network in communication with the at least one server, and a plurality of client computers. A system in general, and servers and client computers in a distributed computer network in specific, can fairly be characterized as one or more machines, and do not fall within one of the judicial exceptions.

Independent claim 41 is directed to a computer readable medium on which is stored computer program code for implementing the method discussed in regard to claim 1 and centralized on at least one server and carried out over a distributed computer network to a plurality of client computers. Therefore, because claim 41 is directed to a computer readable medium storing computer program code that is operated on a machine, independent claim 41 does not fall within one of the judicial exceptions. As set forth above, Applicants' independent claims involve a functional interrelationship among information and computing actions performed using the information. As such, a claim to that computer readable medium is statutory subject matter because it involves a statutory manufacture.

Third, even if the claims do fall within a judicial exception, the claims provide a practical application because they produce a useful, concrete, and tangible result. As stated in MPEP § 2106[IV][C][1], p. 2100-11: "The conclusion that a particular claim includes a 35 U.S.C. 101 judicial exception does not end the inquiry because the practical application of a judicial exception may qualify for patent protection." A claimed invention is directed to a practical

application of a 35 U.S.C. 101 judicial exception when it produces a “useful, concrete, and tangible result.” (MPEP § 2106[IV][C][2], pp. 2100-11) Moreover, if the Examiner finds a practical application, the Examiner shall end the inquiry and find that the claim meets the statutory requirement of 35 U.S.C. 101. (MPEP § 2106[IV][C][2], pp. 2100-11)

In the Office Action, claims 1-6, 8-26, 28-46, and 48-60 were rejected because, as to a single limitation in each of independent claims 1, 21, and 41, the “[step of] assigning of access rights to received information itself can not produce useful, concrete or tangible result without using or having means adapted to using the assigned access rights in the claimed invention to generate a useful and concrete results [sic].” (Office Action, p. 3) But the wrong standard was applied. The right standard, as stated in the MPEP, focuses “...not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is ‘useful, tangible, and concrete.’” (emphasis added) (MPEP § 2106[IV][C]2, p. 2100-12)

Here, independent claims 1, 21, and 41 produce a useful, tangible, and concrete result and, therefore, claims 1, 21, and 41 are directed to a practical application. Claims 1, 21, and 41 are directed to automating real estate transfers, wherein information is received and associated with a real estate record using a record identifier associated with the record. As a useful, concrete, and tangible result, the now associated information can be stored in association with the real estate record.

Moreover, the result of claims 1, 21, and 41 are at least as tangible as the results held by the Court of Appeals of the Federal Circuit to be tangible results. In *Alappat*, for example, the Court held that a smooth wave produced by a machine through a series of mathematical

calculations on data produced a tangible result. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ 1596, 1601 (Fed. Cir. 1998) referring to *In Re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994). Likewise, in *Arrhythmia*, the Court held that transformation of electrocardiograph signals from a patient's heartbeat through mathematical calculations corresponded to a useful, concrete, or tangible thing – the condition of a patient's heart. *State Street Bank*, 149 F.3d at 1373, 47 USPQ at 1601 referring to *Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992). Moreover, the court held in *State Street Bank* that the mere transformation of data, representing dollar amounts, through mathematical calculations into a final share price produced a tangible result. *id.* at 1601. The result of claims 1, 21, and 41 - the active association of information with a real estate record using a record identifier – is at least as tangible as the smooth waveform in *Alappat*, the transformation of electrocardiograph signals in *Arrhythmia*, or the final share price in *State Street Bank*. Therefore, claims 1, 21, and 41 produce a useful, concrete, and tangible result as defined by the Federal Circuit and are directed to a practical application.

Fourth, the fact that this rejection appears for the first time so far into prosecution is strong evidence that the rejection is weak and unwarranted. It is the Applicants' opinion that the current rejection under 35 USC §101 is untimely and violates the principles of compact prosecution, as mandated in the MPEP. With reference to MPEP §2106, it states,

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to deficient with respect

to some statutory requirement. Thus, personnel should state all reasons and bases for rejecting claims *in the first Office Action*. (emphasis added.)

To bring a non-statutory rejection at this point in the prosecution (after the Applicants have already incurred the time and expense of filing two fully responsive office action responses and a Request for Continuing Examination (RCE)), in the Applicants' opinion, is an obvious violation of the articulated principles of compact prosecution and unfairly burdens the Applicants. It is respectfully pointed out that the flowchart provided in MPEP §2106 instructs examiners to address issues pertaining to 35 USC §101 as *one of the first items* performed in the prosecution of a case. If this rejection had any basis in fact or law at all, then it certainly would have warranted being raised from the outset. Moreover, Applicants did not remove subject matter from their originally filed claims that could have warranted this late rejection. Therefore, the fact that this rejection was not initially set forth in the first Office Action is strong evidence that it is entirely without merit.

In summary, Applicants respectfully submit that claims 1, 21, and 41 define a process, machine, and manufacture that do not fall within a judicial exception to statutory subject matter under §101. Moreover, even if the claims appeared to fall within a judicial exception, the claims are directed to statutory subject matter because they define a practical application that provides a "useful, concrete, and tangible result." Claims 2-6 and 8-20 ultimately depend from claim 1. Claims 22-26 and 28-40 ultimately depend from claim 21. Claims 42-46 and 48-60 ultimately depend from claim 41. Thus, dependent claims 2-6, 8-20, 22-26, 28-40, 42-46, and 48-60 are directed to statutory subject matter because of depending from independent claims 1, 21, and 41, and are independently directed to statutory subject matter because they recite further limitations that define further useful, concrete, and tangible results. For these reasons, as well as the reasons

stated above, claims 1-6, 8-26, 28-46, and 48-60 are directed to patentable subject matter.

Applicants respectfully request reconsideration and withdrawal of the § 101 rejection.

B. Claim Rejections under 35 U.S.C. § 112, ¶ 1

Claims 1-6, 8-26, 28-46, and 48-60 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully assert that the rejection, and its rationale, are improper for the following reasons.

In the rationale from the Office Action, it is asserted that “Applicant has not positively claimed how record identifier for each of the plurality of information is associated with a particular real estate record...” (emphasis added) Similarly, it is asserted that “applicant has not clearly disclosed how information received from remote sources...is for a transaction related to a particular real estate [sic] because there is no claimed limitation that the information received from a remote source has real estate identification information to enable the automation system as claimed by the invention to be able to properly make the association of the received information to the proper real estate as intended by the user of the invention.” (emphasis added)

But 35 U.S.C. § 112 requires that the specification – not the claims – shall contain a written description of the manner and process of making and using the invention to enable any person skilled in the art to make and use the same. Because the rejection focuses on the claims – instead of the specification – it is clear that the rejection is fundamentally unsound. In any event, the specification does, in fact, enable skilled artisans to make and use Applicants’ claimed invention.

First, the reasoning in lines 6-7 on page 4 of the Office Action will be addressed. Contrary to the reasoning, each real estate record may be assigned a record identifier as set forth

at least in ¶¶ 0153 and 0292 of Applicants' description. Also contrary to the reasoning, Applicants' specification does not mention "duplicate real estate records" and it is not at all understood what the Examiner is trying to assert here. Therefore, the rejection appears to be without reasonable basis.

Second, the reasoning in lines 12-13 on page 4 of the Office Action basically states that there is no claimed limitation that information received can properly be associated with a proper real estate record. But a review of Applicants' specification reveals that information received is associated with a real estate record with a record identifier (e.g. a Document Routing Number) which can be used, for example, in a fax embodiment, an email embodiment, or any other suitable embodiment. A portion of the exemplary fax embodiment is discussed in paragraphs 0272-0279, and a portion of the exemplary email embodiment is discussed in paragraphs 0280-0288.

Third, and as stated in MPEP § 2164.04, "[i]n accordance with the principles of compact prosecution, if an enablement rejection is appropriate, the first Office action on the merits should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal. *** The principles of compact prosecution also dictate that if an enablement rejection is appropriate and the examiner recognizes limitations that would render the claims enabled, the examiner should note such limitations to applicant as early in the prosecution as possible. In other words, the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application." (emphasis added)

If the § 112, ¶ 1 rejection had any basis in fact or law at all, then it certainly would have warranted being raised from the outset. Moreover, Applicants did not remove subject matter from their originally filed claims that could have warranted this late rejection. Therefore, the fact that this rejection was not initially set forth in the first Office Action is strong evidence that it is entirely without merit.

In summary, Applicants respectfully submit, at least for the reasons presented above, that the present application includes sufficient enabling disclosure for the claimed invention. The Applicants have disclosed their invention in conformance with 35 U.S.C. § 112 by disclosing sufficient detail of the invention to enable one skilled in the art to make and practice the invention without undue experimentation when the totality of the application is review having in mind the nature of the invention, the state of the art, and the relative skill of those in the art. In other words, one skilled in the art, when reviewing the detailed description of the present invention, together with the drawings, would be able to make and use the present invention without undue experimentation since the invention is directed to a novel arrangement of modified components, varying in ways from known components which are retrospectively apparent from such known components and Applicants' disclosure. Accordingly, reconsideration and withdrawal of the rejection of claims under 35 U.S.C. § 112, ¶ 1 is respectfully requested.

C. Claim Rejections under 35 U.S.C. § 112, ¶ 2

Claims "1-6, 1-20 [sic], 41-46, and 48-60" were rejected under 35 U.S.C. § 112, second paragraph, as being vague and indefinite, for example, allegedly because Applicants have not positively claimed how information received is associated with real estate. While Applicants are

of the opinion that the claims are, in fact, definite as originally filed, Applicants have amended the claims to further clarify the claimed invention.

Applicants assert that no new matter has been added, that the claims particularly point out and distinctly claim the subject matter that Applicants regard as the invention, and that the amended independent claims as well as the claims depending therefrom are allowable. Accordingly, reconsideration and withdrawal of the rejection of claims “1-6, 1-20 [sic], 41-46, and 48-60” under 35 U.S.C. § 112, ¶ 1 is respectfully requested.

D. Claim Rejections Under 35 U.S.C. § 103

The Office Action rejected claims 1-6, 8-26, 28-46, and 48-60 under 35 U.S.C. § 103 as being unpatentable over Raveis, U.S. Publication 2002/0049624, in view of the teachings of Watanabe, JP Patent 2001-274946. Applicants respectfully traverse each of the 35 U.S.C. § 103 rejections set forth herein in view of the claims as amended and for the reason that Applicants’ invention is patentably distinguishable, and not an obvious improvement, over the cited references.

1. Incomplete Obviousness Rejection

The Office Action does not present a complete obviousness rejection. According to MPEP § 706.02(j), a complete obviousness rejection requires an Office Action to set forth the following elements:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);

(C) the proposed modifications of the applied references necessary to arrive at the claimed subject matter; and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

Here, the Office Action does not set forth proposed modifications of the applied references. The Office Action merely asserts that it would be obvious “to modify Raveis as taught by Watanabe...” But Watanabe does not even mention Raveis, much less teach any modifications to Raveis. Notably, the Office Action does not propose any specific modifications of each of the Raveis and Watanabe references that would be necessary to successfully combine the references to arrive at the claimed subject matter. Applicants assert that this failure is evidence that such a combination is not reasonably desirable or feasible, which militates against the obviousness rejection of Applicants’ invention. In any case, the Office Action does not adequately communicate the basis for the obviousness rejection such that Applicants have not been given a full and fair opportunity to develop a reply. In other words, Applicants respectfully assert that the Office Action does not clearly and fully explain the rationale for the obviousness rejection. Therefore, Applicants respectfully assert that making the next Office Action final would be improper.

2. No *Prima Facie* Case of Obviousness

The Office Action does not set forth a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness according to MPEP § 706.02(j), the cited references must teach or suggest all of Applicants’ claim limitations, and there must be some suggestion to modify or combine reference teachings and a reasonable expectation of success in doing so.

a. Cited References Are Missing Elements Of Applicants' Invention

i. Combination Of Raveis And Watanabe References

Foremost, it is apparent that the cited references do not teach or suggest all of Applicants' claim limitations. Even assuming, *arguendo*, that there is a suggestion or motivation to combine the cited references, there are fundamental differences between the claimed invention and the individual cited references and any combination thereof, such that all of the claim limitations of Applicants' invention are not met by Raveis or Watanabe or any combination thereof.

Raveis was cited by Applicants upon filing of their application, and is directed to the shortcomings of business models for real estate companies that fail to maintain customer relationships and leave a homeowner trying to manage repairs and improvements with little more than a telephone book for assistance. (¶ 0014) Raveis teaches a solution to such shortcomings in the form of an improved system and method of using a distributed computing network to facilitate maintaining customer relationships and information appertaining thereto. (¶ 0016) In accordance with such teachings, Raveis discloses a method including generating a customer record including fields for entering an estimated completion date and an actual completion date for each of a plurality of stages of a real estate transaction. According to the method, access to a customer and a real estate agent is provided to the customer record over the distributed computing network to facilitate entry of estimated and actual completion dates for the stages of the real estate transaction. Also, a transaction coordinator is provided access to the customer record through a server based application to facilitate the coordinator's entry of estimated and actual completion dates for stages of the real estate transaction in appropriate fields of the customer record. (¶ 0018)

Watanabe is directed to labor burdens and compromised conservation goals because a document to be faxed must first be printed out and then transmitted using a fax machine (6) to transmit the document to a destination fax machine (7). (Page 1, Summary; Fig. 5) As a solution to this problem, Watanabe teaches transmitting a special cover sheet having receiver ID information and being attached to the document to be faxed. In accordance with these teachings, Watanabe discloses an electronic filing method. First, a special cover sheet is set into an image scanner (30) (Fig. 1; Fig. 2, ST1; ¶ 0024). Second, image information on the special cover sheet is acquired into an electronic terminal (23) (Fig. 1; Fig. 2, ST2; ¶ 0025). Third, a communications document (e.g. letter, etc) is imaged at the same time as the special cover sheet (Fig. 3, ST3; ¶ 0025). Fourth, a client using the electronic terminal outputs a transmission request to a fax server (30) (Fig. 1; Fig. 2, ST4; ¶ 0026). Fifth, a reply is received affirming acceptance of the transmission (Fig. 2, ST5; ¶ 0026). Sixth, image information from the special cover sheet is attached to the image information on the communications document, and then output to the fax server (Fig. 2, ST6; ¶ 0026). Seventh, the fax server transmits the image information to a DSP electronic filing device (12) (Fig. 1; Fig. 2, ST7; ¶ 0026). Eighth, the image information is received (Fig. 2, ST8; ¶ 0027). Ninth, the fax server executes a routine for decoding the receiver ID information scripted on the special cover sheet (Fig. 2, ST9; ¶ 0027). Tenth, the fax server specifies a document storage area for a receiver (client) at an electronic filing server (29) and stores the image information of the communications document in the document storage area (Fig. 1; Fig. 2, ST10; ¶ 0028). Eleventh, the fax server issues a reception notice to an electronic terminal (26) being operated by the receiver (client) (Fig. 1; Fig. 2, ST11; ¶ 0029).

Applicants' invention is directed to the problems associated with a real estate transfer process, including inability to quickly and easily associate documentation with respective records in a database via email and/or fax transmissions from multiple locations. Accordingly, Applicants teach automating the process of transferring real estate. According to an exemplary fax embodiment, Applicants disclose that a real estate record is created, and a record identifier is assigned to the real estate record. Also, information is received from any fax source, and a sender of the information is prompted to input the record identifier into the fax source. The information is associated with the real estate record using the record identifier, and the information is stored in association with the real estate record. Other exemplary embodiments are disclosed including direct entry and email embodiments.

Applicants' amended independent claims 1, 21, and 41 recite, *inter alia*, assigning a record identifier to a real estate record, prompting a sender of information to input a record identifier into a fax source, and associating information received from the fax source to a real estate record using the record identifier.

The Office Action generally alleges that Raveis suggests the claimed invention of claims 1, 21, and 41 except for receiving information from facsimile equipment, which the Office Action further alleges is disclosed by Watanabe. The Office Action also alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Raveis "as taught by Watanabe" to electronically file documents received from parties involved in a transaction. (see Office Action page 6).

The Applicants respectfully disagree with the above allegations because there are significant differences between Applicants' invention and Raveis, or Watanabe, or any

combination thereof. First, out of the many limitations in Applicants' claims 1, 21, and 41, the Office Action sets forth only that Raveis teaches creating a real estate record on a server and receiving information from a plurality of sources. Moreover, Raveis and Watanabe fail to disclose, teach, or suggest, assigning a record identifier to a real estate record and associating received information to the real estate record using the record identifier. Nowhere is there any mention in either reference of record identifiers, assigning a record identifier to a real estate record, prompting a sender of information to input the record identifier into a fax source, and associating the real estate record to the received information using the record identifier. The Office Action cites ¶ 0009 of Watanabe, but a review of this paragraph reveals that Watanabe recites a "receiver ID" to identify "receivers". But Watanabe does not define a receiver or a receiver ID in any way, shape, or form. Watanabe's receiver ID may or may not be an identification but, in any case, is not an identifier of a record per Applicants' invention.

Therefore, notwithstanding the fact that the combination of the Raveis and Watanabe references as suggested by the Office Action is not legally justified as will be discussed below, Applicants' claims would still have novel and unobvious physical features over the proposed combination. In other words, any attempt at combining the cited references does not disclose all of the claimed features of Applicants' invention and, therefore, the combination would necessarily constitute a different function and different result than the claimed invention.

b. No Basis to Combine the Cited References And No Reasonable Expectation Of Success In Doing So

One of ordinary skill in the art would have no basis for combining the teachings of Raveis and Watanabe in order to attempt to replicate Applicants' invention because, for example, there is no teaching, suggestion or motivation in the art to do so.

First, the Office Action asserts that the motivation to combine Raveis and Watanabe is for the purpose of electronically filing documents received from parties in a transaction. But, this alleged motivation is a stated object of Watanabe, and such object is apparently satisfied using the teachings of Watanabe. Since this object is already satisfied by Watanabe's own teachings, it is impossible to see how such a satisfied object could be the motivation for modifying Raveis for use with Watanabe.

Second, the solutions taught by Raveis and Watanabe are directed to problems totally different than that of Applicants' invention. For example, Raveis is directed to the problem of shortcomings of business models for real estate companies that fail to maintain customer relationships and that leave a homeowner trying to manage repairs and improvements with little more than a telephone book for assistance. Also, the teachings of Watanabe are a solution for the problem of having to first print out a document to be faxed before transmitting the document using a fax machine.

In contrast, Applicants' teachings are directed to a problem not even recognized in the cited references when considering all the cited references singularly or collectively. Not a single applied reference mentions the potential problem of the inability to quickly and easily associate documentation with respective records in a database via, for example, email and/or fax transmissions from multiple locations. Absent a recognition of this problem, it would be impossible for its solution to be obvious to any one, and the cited references cannot possibly suggest, singularly or in combination, a solution as novel as Applicants' invention.

Third, Watanabe teaches away from Applicants' invention. Whereas Watanabe teaches a complex multi-step process of scanning a special cover sheet and a document to be faxed,

Applicants teach an elegant one step process for input of a record identifier. More specifically, Watanabe teaches transmitting a special cover sheet having receiver ID information and being attached to a document to be faxed, wherein the special cover sheet is set into an image scanner (ST1), and image information on the special cover sheet is acquired into an electronic terminal (ST2). In contrast, Applicants teach prompting a sender to input a record identifier into a fax source. Watanabe's multi-step use of a separate special cover sheet is the opposite of Applicants' single step use of a record identifier.

Thus, not only does Raveis and Watanabe not meet all of Applicants' claim limitations, the Watanabe reference essentially teaches the opposite of Applicants claims. As stated in the MPEP, if any of the cited references teach away from the suggested combination, or teach away from the claims, or render any of the cited references unsatisfactory for their intended purpose, the claimed invention is distinguishable over the combination of cited references. See MPEP § 2145(X)(D)(1-2); 2141.02(VI) A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Fourth, one of ordinary skill in the art would not attempt to combine the references to yield the Applicants' invention in the manner suggested in the Office Action, because the suggested combination would result in a nonfunctional system. The resulting effect of the combination would be a method of tracking real estate transactions including generating a customer record with entry fields for entering estimated completion and actual completion dates for each of a plurality of stages of a real estate transaction and then, somehow, associating

therewith received fax communications having a special cover sheet having receiver ID information for identifying receivers.

Exactly what is to be done with Watanabe's faxed communication is certainly not clear from the teachings of Raveis, Jr., wherein each of several users, i.e. real estate agent, transaction coordinator, and customers access a real estate tracking system for purposes of entering estimated dates and actual completion dates for different stages of a real estate transaction so that progress reports with respect to the overall process may be provided to a customer as well as facilitate managing customer relations and information pertaining thereto. More specifically, there is absolutely no discussion as to how Raveis would accommodate Watanabe's faxed communication, and it is impossible to understand how Watanabe's faxed communication could be entered into the date tracking records of Raveis, Jr. in the form of an estimated or actual completion date or in any other form.

The Office Action lacks a proper *prima facie* showing of obviousness because the Office Action does not provide any teaching, suggestion, or motivation for combining the cited references and does not provide a proper reason to support the proposed combination. In fact, it is only through Applicants' own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a combination of the elements provided according to Applicants' claims in order to solve the problems associated with the inability to quickly and easily associate documentation with respective records in a database via, for example, email and/or fax transmissions from multiple locations. In other words, but for Applicants' disclosure, there is no teaching, suggestion, or motivation whatsoever to combine Raveis and Watanabe in any way in order to obviate Applicants' invention. Accordingly, Applicants respectfully assert that the

Office Action is an example of hindsight reconstruction in an attempt to obviate Applicants' invention after having the benefit of reading Applicants' disclosure.

3. Summary

Applicants' invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of record in this application. When viewed singularly or collectively, none of the cited references disclose, teach, or even suggest assigning a record identifier to a real estate record, prompting a sender of information to input a record identifier into a fax source, and associating information received from the fax source to a real estate record using the record identifier and, in fact, Applicants perform this for the first time. Thus, independent claims 1, 21, and 41 are not rendered obvious by any of the cited references. Under principles of claim dependency and for at least the reasons stated above, Raveis and Watanabe do not render obvious any of the dependent claims either. Therefore, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

III. CONCLUSION

In view of the foregoing remarks, the Applicants respectfully submit that the pending independent and dependent claims are in proper form, define patentably over the cited references, and are all allowable. Applicant, therefore, respectfully requests that the Examiner's objections and rejections under 35 U.S.C. §§ 101, 103, and 112 be reconsidered and withdrawn and that a formal and timely Notice of Allowance of the application be issued.

Every attempt has been made to place the claims in condition for allowance and it is respectfully asserted that there are no further issues, formal or substantive, that remain for

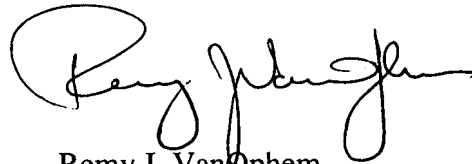
prosecution. Formal allowance of the application is, therefore, respectfully solicited. If the Examiner is not persuaded that all issues are resolved, the undersigned respectfully requests that the Examiner initiate a telephone interview to enable an attempt to be made to resolve any remaining issues. Otherwise, in the event the Examiner is not persuaded of the patentability of the claims he is respectfully requested to enter the amendment for purposes of appeal.

The Commissioner is hereby authorized to charge any deficiency in fee associated with this amendment to the undersigned's Deposit Account No. 22-0212. A duplicate of this page is included.

If the Examiner has any questions with respect to any matter now of record, Applicants' attorney may be reached at (586) 739-7445.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.



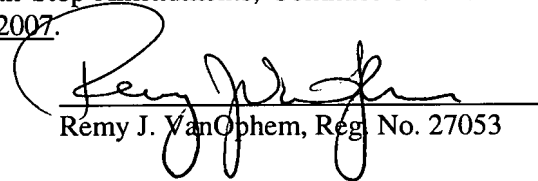
Remy J. VanOphem
Attorney for Applicant
Registration No. 27053

51543 Van Dyke Avenue
Suite 103
Shelby Township, MI 48316-4447
(586) 739-7445
vanpat@wowway.com
Attorney Docket: LDC100A US
RVO/SBW/ndt

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Remy J. VanOphem, Reg. No. 27053